

REMARKS

The claims have been amended for clarity in accordance with many of the Examiner's suggestions and support therefor is found throughout the specification and the originally filed claims. Further, new claims 21-22 are added and are supported at Claims 3 and 13. No new matter is believed to be introduced by the amendment. Finally, Applicants thank Examiner Wong for indicating that Claims 3-20 are allowable if amended in accordance with her suggestions to overcome the 112 rejections.

At the outset, Applicants thank Examiner Wong for the helpful suggestions throughout the Office Action and during a brief courteous discussion of the present application. Further, Applicants thank the Examiner for indicating that the amendment above combined with the remarks below would appear to further favorable prosecution of the present invention.

The objection to the specification is believed to be obviated by the submission of the substitute abstract attached hereto. Accordingly, withdrawal of this ground of objection is respectfully requested.

The rejection of the claims under 35 U.S.C. § 112, second paragraph, is believed to be obviated by the above amendment combined with the remarks below.

In accordance with the Examiner's many suggestions, Applicants amend the claims throughout in a non-limiting fashion so as to ensure that the claims have active process steps where applicable and to ensure proper antecedent basis. Furthermore, Applicants have substituted "furan or a substituted furan" in line 5 for "at least one furan-based starting compound (A)". Furthermore, Applicants have made clear that both C-C double bonds cited in the claims are the same, Applicants have deleted "in parallel" in lines 10/11 and have deleted the second "or" under (ii), in order to clarify the Markush group. Finally, the transition term "wherein the process..." is now found after "electrolysis circuit". Once again,

Applicants thank the Examiner for her many helpful suggestions. Accordingly, withdrawal of this ground of objection is respectfully requested.

The rejections of Claims 1-2 under 35 U.S.C. § 103(a) over Ponomarev et al. is believed to be obviated by the above amendment combined with the remarks below.

Applicants enclose herewith a translation of the original Ponomarev et al. reference. From the lecture of this publication, it becomes clear that the examiner's objection is undue because the examiner states that the difference between the process according to the present invention and Ponomarev et al. lies in the fact that Ponomarev et al. "does not teach using the hydrogen obtained in parallel at the cathode step (i) or hydrogen fed to the electrolysis circuit or electro-catalytic hydrogenation."

Applicants respectfully disagree because as Ponomarev et al. merely teaches the electro-catalytic oxidation of a furan-based starting compound, to give diemethoxydihydrofuran derivatives. The Examiner's attention is directed to pages 991 and 992, and see page 993, right column, first paragraph of Ponomarev et al. which clearly discloses that the thus-obtained dimethoxydihydrofuran derivatives are then converted into the corresponding dimethoxytetrahydrofuran compounds by hydrogenation in alcohol, in the presence of Raney nickel. Further, Ponomarev et al. clearly discloses that the hydrogenation is carried out in a rotating steel autoclave (see page 995, first paragraph).

Thus, the process according to Ponomarev et al. is not carried out in an electrolysis cell in which at least one hydrogenation catalyst is present.

In direct contrast to Ponomarev et al., the claimed invention relates, in part, to a process for the electrolytic transformation of at least one furan-based starting compound (A) in an electrolysis cell in which at least one hydrogenation catalyst is present. Since Ponomarev et al. fails to disclose or suggest a process carried out in an electrolysis cell in which at least one hydrogenation catalyst is present, Ponomarev et al. clearly fails to disclose

or suggest all limitations of the claimed inventions as required by the MPEP (see § 2143.03 and the enclosed copy of *In re Royka* 180 USPQ 580 (CCPA 1974)). Further, it has not been pointed out to the Applicants as to where any specific motivation lies within Ponomarev et al. that would motivate the skilled artisan reading the same to modify the process disclosed therein towards the claimed invention.

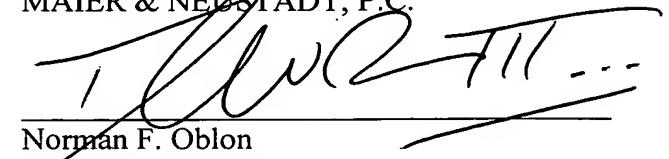
In light of the above, it appears as if the Examiner is relying on the Applicants disclosure to supply motivation to modify the disclosure of Ponomarev et al. to arrive at the claimed invention. However, this is clearly improper according to a recent decision (enclosed) by the U.S. Federal Courts in In re Lee (61 USPQ2D 1430 (CA FC 2002)). The Lee Court indicated that the Office must provide specific motivation, hint, or suggestion, found in the references relied upon to support a *prima facia* case of obviousness. In the present case, the Office appears to rely on the present specification for motivation, which is clearly forbidden according to the Lee Court. In light of this decision, Applicants respectfully request the Office not to use the present specification as a guidepost to combine the disparate disclosures of the cited references (see the enclosed decision in In re Vaeck 20 USPQ 2d 1438).

In light of all of the above, Applicants respectfully request the Examiner to withdraw this ground of rejection.

Should the Examiner believe that anything further is necessary in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Norman F. Oblon
Attorney of Record
Registration No. 24,618

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)

Thomas W. Barnes
Registration No. 52,595